



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/332,625

06/11/1999

JOEL G HASSELL

UV-110

3146

75563

7590

08/21/2008

ROPES & GRAY LLP

PATENT DOCKETING 39/361

1211 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-8704

EXAMINER

SALCE, JASON P

ART UNIT

PAPER NUMBER

2623

MAIL DATE

DELIVERY MODE

08/21/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/332,625	Applicant(s) HASSELL ET AL.	
	Examiner Jason P. Salce	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 41-53,96-108 and 152-164 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 43,45,49,51,98,100,104,106,154,156,160 and 162 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/9/08 and 7/21/08</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims rejected are 41,42,44,46-48,50,52,53,96,97,99,101-103,105,107,108,152,153,155,157-159,161,163 and 164.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 6/12/2008 have been fully considered but they are not persuasive.

Applicant argues Lawler fails to teach that the reminder is set when a particular unique identifier is detected in the continuous data stream and that the examiner provides no basis for modifying the specific mechanism in Lawler so that a reminder is set based on detection of a unique identifier rather than in response to a user activating a button.

The examiner disagrees and notes that the independent claims do not recite setting a reminder, therefore these arguments are moot. Even if the independent claims were to recite such a limitation, Watts clearly discloses prompting/reminding a user that additional content is available for display (**see Column 8, Lines 1-5 and Lines 17-29**).

Applicant further argues that modifying Lawler to set a reminder only when a program is broadcast is functionally illogical because a reminder, by its nature, must be set before the program is broadcast. The examiner agrees with this analysis, however, the examiner has not modified Lawler to set a reminder based on a received unique identifier, the examiner has modified Lawler with the features of Watts to provide a system to display a reminder when a unique identifier has been received.

Applicant also argues that Watts does not describe performing an action associated with at least one other program in a program grouping when a particular identifier is detected in a continuous data stream.

The examiner disagrees and notes that Figure 2 and Column 7, Lines 8-56 for each piece of supplemental data having multiple time periods, which allows the supplemental data to correspond to multiple programs. This is further evidenced at Column 7, Lines 56-60 which states that both a single program and multiple programs can be referenced using the unique identifiers. However, the examiner notes that Watts has not been used to teach these limitations. In the previous Office Action, Lawler has been used to teach these limitations in Figure 8 and Column 11, Lines 40-67.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 5/9/2008 and 7/21/2008 was filed after the mailing date of the Non-Final Rejection on 12/12/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 41-42, 44, 48, 50, 96-97, 99, 103, 105, 152-153, 155, 159 and 161 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (U.S. Patent No. 6,002,394) in view of Lawler et al. (U.S. Patent No. 5,699,107) in further view of Watts et al. (U.S. Patent No. 6,324,694).

Referring to claim 41, Schein discloses an interactive television program guide system in which program guide data is provided (see Column 6, Line 66 through Column 7, Line 9 for receiving program guide data from an EPG provider such as StarSight) and wherein the program guide data includes unique identifiers associated with television programs (see Column 6, Line 66 through Column 7, Line 9 for receiving EPG data, which contains unique identifiers and Figures 4-9 for the different types of EPG data (and unique identifiers, such as title or start time) that can be received).

Schein further discloses that the system comprises a continuous data stream processor configured to select a particular unique identifier (in the EPG data discussed above) associated with television programs for inclusion in a continuous data stream (see Column 12, Lines 27-39 for simultaneously transmitting the program guide data (current and future) in blocks on different transmission bands from a cable television headend (Column 12, Lines 61-63) and contains a continuous data stream processor

Art Unit: 2623

(modulator taught at Column 12, Lines 31-32) used to select the current and future program guide data blocks that are transmitted to the viewer and again note Figures 4-9 for the different types of EPG data that includes a variety of unique identifiers), wherein the particular television program belongs to a program grouping (see Group ID in Figure 6 and multiple types of Theme IDs in Figures 7-9 and further note Column 10, Lines 18-22 for television programs belonging to a series).

Schein further discloses distribution equipment configured to distribute the particular unique identifier to user television equipment in the continuous data stream (see satellite 24 in Figure 1 and headend (Column 12, Lines 61-63) and Column 12, Lines 38-40 for how the satellite is used for transmitting EPG data (with the unique identifiers) in a carousel or endless loop (continuous data stream)).

Schein further discloses an interactive television program guide implemented on the user television equipment (see Figure 16A for the interactive television program guide and PC TV 402 in Figure 15).

Schein further discloses that the interactive program guide is configured to monitor the continuous data stream for the presence of the particular unique identifier (see Column 12, Lines 47-60 for the viewer accessing a current or future program guide data block and if the viewer navigates to a future time portion of the EPG and waiting until the desired block is received from the carousel). Therefore, if a viewer wishes to access a future program guide block, then the viewer must monitor the channel that will have the transmitted future program guide block (with the various unique identifiers). Further note alternatively, that Schein also teaches

Schein further discloses performing a real-time action associated with the particular television program when the particular unique identifier is detected in the continuous data stream (see Column 15, Lines 58-66 for the user setting a reminder (real-time action) for a program using the interactive program guide, which can only be performed if the viewer receives the unique identifiers (EPG data) that is displayed in the viewer's program guide).

Although Schein discloses that television shows can belong to program grouping, Schein fails to teach performing an action associated with at least one other television program belonging to the program grouping.

Lawler discloses that a reminder option can be used to set reminders for a show that is part of a weekly series, therefore teaching performing an action associated with at least one other television program belonging to the program grouping (see Figure 8 and Column 11, Lines 40-67).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the reminder option, as taught by Schein, using the weekly reminder option, as taught by Lawler, for the purpose of allows a to be reminded of, for example, successive episodes of a daily or weekly series by setting only a single reminder (see Column 12, Lines 13-15 of Lawler).

Schein and Lawler are silent about receiving a unique identifier only when the particular television program is currently being broadcasted and the particular unique identifier indicating when the particular television program is being currently broadcasted. Schein also discloses start times for the programs (see Figure 6) and

Art Unit: 2623

transmitting the program guide data to the viewer (see Column 12, Lines 16-60), but does not teach the specifics of when exactly the program guide data will be received.

Watts discloses an interactive television system that receives a program guide (see Column 6, Lines 6-30).

Watts further discloses monitoring the continuous data stream for the presence of the particular unique identifier, wherein the particular unique identifier is distributed when the particular television program is being currently broadcasted (see Column 7, Lines 30-38).

Watts further discloses performing a real-time action associated with the particular television program when the particular unique identifier is detected in the continuous data stream (Column 7, Lines 38-44).

Watts further discloses performing an action associated with the at least one other television program belonging to the program grouping when the particular unique identifier is detected in the continuous data stream **(see Figure 2 and Column 7, Lines 45-60 for multiple actions (triggered by the tag data/data pieces) relating to multiple time periods during a program's broadcast, which trigger an action and further note that each set of actions being further identified into portions/groups).**

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the continuous data stream transmitted to the viewer, as taught by Schein and Lawler, to include the unique identifiers, as taught by Watts, for the purpose of providing subsidiary data (such as a pop-up window or PIP) synchronous to primary data (the television program) (see Column 1, Lines 18-20 of Watts).

Claim 42 corresponds to claim 41, where Lawler discloses a program reminder system, which displaying a reminder to a user before the program is about to be broadcasted (see Figure 9 and Column 12, Lines 35-63).

Referring to claim 44, again note that Watts teachings displaying additional supplemental content according to incoming unique identifiers (see the rejection of claim 41).

Schein further discloses that supplemental content can be in the form of a password window, used to authorize the viewing of a pay-per-view television program (see Figure 18C).

Referring to claim 48, see the rejection of claim 42.

Referring to claim 50, see the rejection of claim 44.

Referring to claims 96 and 152, see the rejection of claim 41.

Referring to claims 97 and 103, see the rejection of claims 42 and 48, respectively.

Referring to claims 99 and 155, see the rejection of claim 44.

Referring to claims 105 and 161, see the rejection of claim 50.

Referring to claims 153 and 159, see the rejection of claims 42 and 48, respectively.

Claims 46, 52, 101, 107, 157 and 163 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (U.S. Patent No. 6,002,394) in view of Lawler et al. (U.S. Patent No. 5,699,107) in further view of Watts et al. (U.S. Patent No. 6,324,694) in further view of Woo (U.S. Patent No. 5,485,219).

Referring to claim 46, Schein, Lawler and Watts disclose all of the limitations in claim 41, but fail to teach that the real-time action comprises recording the particular television program.

Woo discloses a system for transmitting (through a broadcast) ON and OFF recording commands at the time the program (or commercials within a program) is being broadcasted (see Column 1, Lines 51-64).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the unique identifiers, as taught by Schein, Lawler and Watts, using the ON and OFF recording commands, for the purpose of allowing a user to simply select desired programming for recording and identify the recording to be recorded without commercials (see Column 2, Lines 23-25 of Woo).

Referring to claim 52, see the rejection of claim 46.

Referring to claims 101 and 107, see the rejection of claims 46 and 52, respectively.

Referring to claims 157 and 163, see the rejection of claims 46 and 52, respectively.

Claims 47, 53, 102, 108, 158 and 164 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al. (U.S. Patent No. 6,002,394) in view of Lawler et al. (U.S. Patent No. 5,699,107) in further view of Watts et al. (U.S. Patent No. 6,324,694) in further view of Block et al. (U.S. Patent No. 6,675,384).

Referring to claim 47, Schein, Lawler and Watts discloses all of the limitations in claim 41, as well as Schein teaching prompting a user for a control code (see the rejection of claim 44), but fail to teach that the real-time action comprises locking the particular television program.

Block discloses transmitting TIL codes from a broadcaster that allow the client device to lock certain portions of television programs from the viewer as the program is currently being broadcast (see Column 21, Lines 23 through Column 22, Line 24).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the unique identifiers, as taught by Schein, Lawler and Watts, using the TIL information used to lock out a specific television program or portion thereof, as taught by Block, for the purpose of providing an information labeling and control process where a substitute program signal is presented to a user instead of the offensive or undesirable portions of a program (see Column 2, Lines 19-22 of Block).

Referring to claim 53, see the rejection of claim 47.

Referring to claims 102 and 108, see the rejection of claims 47 and 53, respectively.

Referring to claims 158 and 164, see the rejection of claims 47 and 53, respectively.

Allowable Subject Matter

Claims 43, 45, 49, 51, 98, 100, 104, 106, 154, 156, 160 and 162 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2623

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P. Salce whose telephone number is (571) 272-7301. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/
Primary Examiner, Art Unit 2623

Jason P Salce
Primary Examiner
Art Unit 2623

August 19, 2008